

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

The specification has been amended on pages 1-3 and 11.

Claims 2-5 and 7-9 have been canceled.

New claims 28-32 have been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1, 6, and 10-32 are now pending in this application. Claims 22-24, 26, and 27 have been withdrawn from consideration.

### **Priority**

Applicant respectfully requests that the Office acknowledge Applicant's claim for foreign priority in the next Office correspondence.

### **Information Disclosure Statement**

Applicant notes that references A8-A17 were crossed out on the copy of the PTO/SB/08 form enclosed with the Office Action. The Office notes on page 2 of the Office Action that copies of these references were not received. As stated in the Information Disclosure Statement of September 29, 2005, with which the PTO/SB/08 form was filed, Applicant's representative stated that copies of references A8-A16 would be provided directly by WIPO under an exchange program. Applicant's representative submits that this statement was made in good faith and that this exchange program has been discontinued.

Enclosed with this response are copies of references A8-A17. As stated in the Information Disclosure Statement of September 29, 2005, references A8-A16 were cited as being relevant during a search of the corresponding International application. As noted in the Information Disclosure Statement, a commercially available English language abstract is provided herewith as indicated in the PTO/SB/08 form, such as for reference A17.

Applicant respectfully requests that the Office provide a signed and fully initialed copy of the PTO/SB/08 form with the next Office correspondence.

**Rejections under 35 U.S.C. § 112**

Claims 8, 9, 12, and 13 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant respectfully submits that the amendments to the claims render these rejections moot. Reconsideration and withdrawal of these rejections is respectfully requested.

**Rejections under 35 U.S.C. § 103**

Claims 1, 8, 9, 16, and 21

Claims 1, 8, 9, 16, and 21 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over EP 0 163 471 to Fukuda *et al.* (hereafter “Fukuda”). This rejection is respectfully traversed.

Fukuda relates to a descaling and lubricant coating process for a drawn wire rod that is preheated to a temperature of 80°C or higher and then pretreated in a solution at 70°C to 90°C and/or lubricated with a solution at 70°C to 90°C. See Fukuda at page 3, lines 33-38; page 4, lines 1-5; page 6, lines 29-38; page 7, lines 1-10; page 13, lines 8-37.

However, Fukuda does not disclose or suggest a process for producing surface-modified work pieces made from a metal and/or one or more alloys comprising, among other things, treating a workpiece with at least one modifying agent to obtain the surface-modified workpiece, wherein the at least one modifying agent is at a temperature of at least 0°C to at most 100°C, wherein the workpiece to be modified is provided at a temperature of from 300 to 550°C, as recited in claim 1, because Fukuda does not disclose or suggest the processing temperatures of claim 1. For example, Fukuda does not disclose or suggest treating a workpiece with a modifying agent that is at a lower temperature than the workpiece, such as the temperatures recited in claim 1. Thus, Fukuda does not disclose or suggest all of the features of claim 1.

The Office argues on page 4 of the Office Action that the ranges recited in claim 1 are obvious design choices in the absence of unexpected results. However, the Office does not provide any particular rationale for why one of ordinary skill in the art would have modified the process of Fukuda to provide the features of claim 1, other than a general argument that

such a modification would be a matter of design choice. However, such an argument is not a sufficient rationale or explanation why one of ordinary skill in the art would have modified the process of Fukuda to provide the particular ranges recited in claim 1.

Applicant notes that a parameter must first be recognized as a result-effective variable before the determination of optimal or workable ranges of the variable can be characterized as routine experimentation. See MPEP § 2144.05, Part IIB, citing *In re Antonie*, 195 USPQ 6 (CCPA 1977) and *In re Boesch*, 205 USPQ 215 (CCPA 1980). Furthermore, the lack of objective evidence of nonobviousness, such as unexpected results, does not weigh in favor of obviousness, as argued by the Office. See MPEP § 716.01(a), citing *Miles Labs. Inc. v. Shandon Inc.*, 997 F.2d 870, 878, 27 USPQ2d 1123, 1129 (Fed. Cir. 1993), *cert. denied*, 127 L. Ed. 232 (1994).

For at least the reasons discussed above, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 5-7, 11, 15, 17, and 18

Claims 5-7, 11, 15, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of GB 863,098. This rejection is respectfully traversed. GB 863,098 fails to remedy the deficiencies of Fukuda discussed above in regard to independent claim 1, from which claims 6, 11, 15, 17, and 18 depend. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 12-14 and 19

Claims 12-14 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of U.S. Patent No. 5,750,197 to van Ooij *et al.* (hereafter “van Ooij”). This rejection is respectfully traversed. Van Ooij fails to remedy the deficiencies of Fukuda discussed above in regard to independent claim 1, from which claims 12-14 and 19 depend. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 10 and 25

Claims 10 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of U.S. Patent No. 2,809,423 to Hanink (hereafter “Hanink”). This rejection is respectfully traversed. Hanink fails to remedy the deficiencies of Fukuda discussed above

in regard to independent claim 1, from which claims 10 and 25 depend. Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 20

Claim 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of “Thermal Modeling of Controlled Atmosphere Brazing Process Using Virtual Reality Technology” by Ratts *et al.* (hereafter “Ratts”). This rejection is respectfully traversed. Ratts fails to remedy the deficiencies of Fukuda discussed above in regard to independent claim 1, from which claim 20 depends. Reconsideration and withdrawal of this rejection is respectfully requested.

**Double Patenting**

Claims 1, 6-19, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4-6, 17, and 19-32 of U.S. Application No. 11/576,918. Because this is a provisional rejection regarding another application currently being prosecuted, Applicant respectfully requests that this rejection be held in abeyance.

**New Claims**

New claims 28-32 have been added. Claims 28-32 depend from claim 1 and are allowable over the prior art for at least the reasons discussed above and for their respective additional recitations.

**CONCLUSION**

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or

even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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